

PATENT  
514413-3766**REMARKS**

Consideration and entry of this paper are respectfully requested in view of the herein remarks, which place the application in condition for allowance.

**I. STATUS OF CLAIMS**

Claims 16-20, 22-27, 29-34, 37 and 39-42 are pending. Claims 16, 24, 25 and 37 have been amended and claim 38 has been cancelled. It is believed that no new matter has been added.

The applicants thank the Examiner for acknowledging claims 16-20, 22, 23 and 38-42 were allowable over the cited prior art.

As the claims prior to this amendment were deemed to be allowable, it is submitted that the claims as amended remain patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112. The amendments of the claims, as presented herein, are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101 or 112. Rather, these amendments and additions are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

**II. THE 35 U.S.C. 102 REJECTIONS HAVE BEEN OVERCOME**

Claims 24, 25, 27, 30 and 34 were rejected as allegedly being anticipated by Gimesi et al. (U.S. Patent 4,445,927 - "Gimesi").

The basis for this rejection is that Gimesi allegedly teaches the "synergistic combination of glyphosate acid with an arylacetic acid such as 2,4-D". In order to expedite prosecution of the claims, the element 2,4-D has been deleted from the claims. The applicants reserve the right to pursue the scope of the claims prior to amendment in a continuing application.

As all elements of the applicants claims are no longer taught by Gimesi, the rejection based on anticipation can be withdrawn.

**III. THE 35 U.S.C. 103 REJECTIONS HAVE BEEN OVERCOME**

Claims 24, 25, 27, 29, 30, 33, 34 and 38 were rejected as allegedly being obvious over Gimesi et al., *supra*.

The primary basis for this rejection appeared to be based on the anticipation rejection made above (i.e. "anticipation is the epitome of obviousness"). However, since the element 2,4-D has been deleted, there is no longer any overlap with Gimesi reference and therefore there is an additional unaccounted for difference between the claimed invention and the Gimesi

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reference. Since all limitations have not been taught, there is no *prima facie* case of obviousness and this rejection can also be withdrawn.

Claims 24-27, 29-34, 37 and 38 were rejected as allegedly being obvious over Gimesi et al., *supra* or Lee et al. (U.S. Patent 6,586,367 - "Lee") in view of Anderson (*Weed Science: Principles and Applications*, 3<sup>rd</sup> ed. Chapters 12 ("Acid Amide Herbicides"), 19 ("Growth Regulator-Type Herbicides") and 27 ("Triazine Herbicides"), pages 165-170, 193-199, 232-239 (1996)).

1. The arguments provided above with respect to Gimesi alone are to be considered repeated here. Furthermore, with the amendment to the claims, neither the combinations of Gimesi or Lee are encompassed by the claims as pending which creates another unaccounted for difference between the claimed invention and the Gimesi and Lee references (applicants reiterate their right to pursue the scope of the claim prior to amendment in a continuing application).

2. In addition, developing a *prima facie* case of obviousness requires more than merely finding each of the individual elements of the applicants invention. The examiner stated that "[o]ne of ordinary skill in the art would have the requisite skill to select appropriate secondary herbicides based upon the known herbicidal spectrum of activity of the second herbicide to enhance the herbicidal utility of the combination."

3. However, while the Examiner has the benefit of the applicants' claims before him for the purposes of examination, the hypothetical person skilled in the art presented with the references cited by the Examiner at the time the applicants' invention was made does not have this luxury. For this skilled artisan, there would be no direction or guidance to produce the herbicidal compositions presently claimed without resorting to improper "picking and choosing" from amongst the many options available in the Gimesi and Lee references.

4. The Anderson reference was used to buttress the position that one of ordinary skill in the art would have been able to generically select the necessary herbicides to approximate the applicants claimed invention. However, Anderson would not lead the skilled artisan to the same conclusion as the Examiner especially in the absence of the applicants' claims before him.

5. The Anderson reference names common characteristics only for the herbicide class "Acid Amide Herbicides" (which includes acetochlor, dimethenamid, metoachlor and alachlor) which is no longer encompassed by the applicants' claims. Regarding the herbicide class "Triazine Herbicides", while there are five common characteristics cited, there immediately follows *thirteen* exceptional characteristics which belie the Examiner's position that one compound is

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necessarily generic for other compounds in a herbicidal class. The compounds atrazine and simazine have been deleted from the claims which Anderson acknowledges has specific characteristics which differentiate it from cyanazine (which remains in the claim language). With regard to "Growth Regulator-Type Herbicides", the Anderson states there are no common characteristics, i.e. the class is heterogeneous. Moreover, two compounds in this class which had some structural similarity (2,4-D and MCPA - both being phenoxy-carboxylic herbicides) are no longer encompassed by the claims nor are two compounds belonging to different structural classes (dicamba and clopyralid).

6. As stated in paragraph 1, all claim limitations have not been taught and on this ground alone, the claims as amended are not obvious over Gimesi or Lee in view of Anderson. In addition, the citation of the Anderson reference weakens rather than strengthens the proposition that any difference between Gimesi or Lee and the claims as amended are obvious and that one of ordinary skill in the art have these references before him but without the applicants claims to act as a roadmap would have been able to approximate the applicants' claimed invention. For any of these reasons, the obviousness rejection can be withdrawn.

#### **REQUEST FOR INTERVIEW**

In the interest of adhering to the tenets of compact prosecution and obtaining good customer service (see page 7 of the FY-2004 Performance and Accountability Report), the applicants request that the teachings of MPEP 707.07(j), sections II and III be applied, especially with regard Examiner's suggestions for claim amendments if the rejections are upheld.

In accordance with MPEP 713.01, section III, should any issue remain as an impediment to allowance, an interview with the Examiner and SPE are respectfully requested; and, the Examiner is additionally requested to contact the undersigned to arrange a mutually convenient time and manner for such an interview ("An interview should normally be arranged for in advance, as by letter, facsimile, electronic mail, telegram or telephone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the office." *Id.*).

#### **CONCLUSION**

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably

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from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,

FROMMER LAWRENCE & HAUG LLP  
Attorneys for ApplicantsBy Howard C. Lee  
Marilyn M. Brogan      Howard C. Lee  
Reg. No. 31,233      Reg. No. 48,104Phone: (212) 588-0800  
Fax: (212) 588-0500